

## **REMARKS/ARGUMENTS**

### **Status of Claims**

Please note that while the Disposition of Claims section of the Office Action Summary Page indicates that Claims 2, 4, 7, 8, and 10-16 are pending, Applicants are of the opinion that Claims 1, 4, 7, 8 and 10-16 are pending.

The difference between the two claim sets results from confusion regarding the status of claims 1 and 2. Because claim 2 was canceled in the Amendment filed on December 23, 2004, in a cancellation which has been acknowledged in the comments the Examiner made on page 2 of the Final Office Action, Applicants assume that the Examiner meant to indicate that claim 1, and not claim 2 is pending. This assumption is consistent with the observation that Point 5 of the Final Office Action indicates that claims "1, 4, 12, and 16 are allowable" (Office Action, page 5).

Claim 7 which was previously withdraw from consideration for being drawn to non-elected subject matter is also canceled.

Claims 10, 11 and 14, which remain under rejection have been canceled.

Claims 8, 13 and 15 have been amended.

Claims 1, 4, 12 and 16 are allowable.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner. The cancellation of claims 10, 11 and 14 removes three of the claims which are under final rejection from consideration. Applicants submit that the amendments proposed for Claims 8, 13 and 15 do not raise any new issues and should only require a cursory review by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

### **Claim Amendment(s)**

In order to expedite the allowance of claims 1, 4, 12 and 16, Applicants have canceled claims 10, 11 and 14 without prejudice. The canceled claims are drawn to isolated nucleic acids (claims 10 and 11) which encode a polypeptide that functions as a human motilin receptor, and an expression vector (claims 14). Applicants expressly reserve the right to pursue the subject matter of the canceled claims in a continuing application.

Claim 8, which is drawn to a method for “determining whether a test compound is capable of agonizing or antagonizing motilin binding”, has been amended to recite:

A method for determining whether a test compound is capable of agonizing or antagonizing motilin binding comprising:

- (a) transfecting indicator cells with an expression vector comprising a nucleic acid encoding a polypeptide consisting of the amino acid sequence set forth in SEQ ID NO: 3 which functions as a receptor for motilin;
- (b) exposing the indicator cells to the test compound in the presence of detectably labeled motilin;
- (c) measuring the amount of motilin binding to the indicator cells;
- (d) comparing the amount of motilin binding to the indicator cells with the amount of motilin binding to cells exposed to the detectably-labeled motilin in the absence of a test compound;

wherein if the amount of motilin binding to the indicator cells in the presence of the test compound differs from the amount of motilin binding in the absence of the test compound, then the test compound is capable of agonizing or antagonizing to motilin binding.

Claim 13 has been amended to recite:

An expression vector comprising a cDNA according to Claim 12.

The proposed amendment of Claim 13 changes its dependency from Claim 10, which has been canceled by the instant amendment, to Claim 12 which recites subject matter (i.e., a cDNA) that the Examiner has found to be allowable.

Claim 15 has been amended to recite:

A recombinant host cell transfected with a vector according to Claim 13.

The proposed amendment of Claim 15 changes its dependency from Claim 14, which has been canceled by the instant amendment, to Claim 13.

No new matter has been added by virtue of this amendment.

**The Rejection of Claim 8 Under 35 U.S.C. §112, Second Paragraphs should be Withdrawn**

Claim 8 remains rejected under 35 USC, §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which Applicants regard as the invention.

More specifically, Claim 8 was alleged to be indefinite because “it is not clear what Applicant is claiming in subsection (a) of claim 8” (Office Action, page 2), which previously read:

(a) transfecting indicator cells with an expression vector set forth in consisting of the nucleotide sequence set forth in SEQ ID NO: 1 or SEQ ID NO: 2.

As amended subsection (a) now reads:

(a) transfecting indicator cells with an expression vector comprising a nucleic acid encoding a polypeptide consisting of the amino acid sequence set forth in SEQ ID NO: 3 which functions as a receptor for motilin;

The proposed amendment utilizes the language of Claim 1, which according to the Examiner's findings recites allowable subject matter, to describe and clarify both the expression vector encompassed by element (a) and the method recited in Claim 8. It should also be noted that Applicants propose 2 additional changes to the language of claim 8. Element (b) has been amended to refer to a "test compound," by the re-introduction of the word "compound" which was inadvertently removed by the last Amendment. In addition, the last line of the wherein clause has been amended to delete the word "to." As amended the wherein clause now concludes with the statement "then the test compound is capable of agonizing or antagonizing motilin binding."

Applicants believe that proposed amendments place claim 8 in condition for allowance and a favorable action on the merits is earnestly solicited.

**The Rejection of Claims 10, 11, and 13-15 Under 35 U.S.C. §102 should be Withdrawn**

Claims 10, 11 and 13-15 remain rejected under 35 USC §102(a) as being anticipated by McKee, K *et al.* (Genomics, 46:426-434 (1997) (cited in IDS). The rejection under 35 U.S.C. §102 was recast in view of the claim amendments submitted by Applicant. The Examiner noted that the rejection of the claims is based on the claims being directed to "nucleic acid comprising language" (Office Action, page 4).

This rejection has been partially obviated by Applicants' decision to cancel claims 10, 11, and 14.

The rejection of Claim 13 has been obviated by changing its base claim from Claim 10, a claim which was under final rejection, to claim 12, a claim which the Examiner has determined recites allowable subject matter. It should be noted that as amended Claim 13 recites an

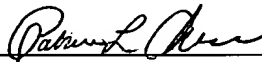
expression vector comprising a cDNA encoding a polypeptide that functions as a human motilin receptor wherein the cDNA *consists of* a defined nucleotide sequence (SEQ ID NO: 1).

The rejection of Claim 15 has been obviated by changing its dependency from Claim 14, a claim which was under final rejection, to newly amended Claim 13.

Conclusion

In summary, Applicant have cancelled three (Claims 10, 11 and 14) claims and amended three claims (Claims 8, 13, and 15) that were under final rejection. In view of the above-described amendments and remarks, Applicants are of the opinion that Claims 1, 4, 8, 12, 13 and 15 and 16 are in condition for allowance. In view of these amendments and the Examiner's findings Applicants respectfully request that the pending claims be allowed.

Respectfully submitted,

By   
Patricia L. Chisholm  
Reg. No. 45,822  
Attorney for Applicant

MERCK & CO., INC.  
P.O. Box 2000  
Rahway, New Jersey 07065-0907  
(732) 594-5738

Date: February 15, 2006